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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,650	08/14/2000	Michael J. Cuttler	4590-004	9848

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PO Box 2974  
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EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/638,650

Applicant(s)

CUTTLER ET AL.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 18-24,36,38-42 and 44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17,25-35,37,43,45 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 18-24,36,38-42 and 44 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **Recent Statutory Changes to 35 U.S.C. § 102(e)**

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the application filed 14 August 2000.  
Claims 1-46 are pending. An IDS statement filed 10 November 2000 has been entered and considered.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-17, 25-35, 37, 43, and 45-46 are drawn to a means for surveying, classified in class 705, subclass 10.
  - II. Claims 18-24, 36, 38-42, and 44 are drawn to a means for determining risk, such as for determining the insurability of an insuree, classified in class 705, subclass 4.
3. The inventions are distinct, each from the other because of the following reasons:  
Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has a separate utility as a means for surveying, including determining specific questions, and invention II has a separate utility as a means for determining the risk of an applicant. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Jeffrey McFadden (Reg. No. 46,916) on February 20, 2003, an provisional election was made without traverse to prosecute the invention of I, claims 1-17, 25-35, 37, 43, and 45-46. Affirmation of this election must be made by Applicant in replying to this Office action. Claims 18-24, 36, 38-42, and 44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The abstract of the disclosure is objected to because it exceeds 150 words.  
Correction is requested. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 17 and 25-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 17 and 25-32, line 1, "the method" lacks proper antecedent basis as claims 17 and 25-32 refer to a method and claim 15 refers to a computer readable medium. For purposes of applying prior art, "the method" of claims 17 and 25-32 is assumed to be a computer readable medium.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-17, 25-35, 37, 43, and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnstetter et al. (5,551,880) in view of Peters et al. (5,893,098) and Sarchione et al. (Sarchione, Charles D., Michael J. Cuttler, Paul M.

Muchinsky, and Rosemary O. Nelson-Gray, "Prediction of Dysfunctional Job Behaviors Among Law Enforcement Officers", *Journal of Applied Psychology*, Vol. 83, No. 6, pp. 904-912, 1998).

(A) As per claim 43, Bonnstetter discloses a method using a computer for predicting the success of an individual for a particular job using measured behavioral and values characteristics of the individual to avoid potentially biasing factors and to have a consistent expert system to allow evaluation of individuals (col. 1 lines 10-15, col. 4 line 63 to col. 5 line 2) comprising:

(a) presenting to the individual selected questions related to behavior and value characteristics relevant to the job (col. 26 lines 37-41);

(b) keying in responses to a computer for the selected questions and storing the answers on a computer disc in a computer (col. 4 line 63 to col. 5 line 2, col. 5 lines 29-42, and col. 6 lines 31-36);

(c) identifying specific factors required to be successful for a particular job at a particular company (col. 2 lines 36-40); and

(d) analyzing and predicting the individuals success for a particular job (col. 2 lines 13-37 and col. 28 lines 11-15).

Bonnstetter fails to expressly disclose storing the responses in a computer database and presenting stem questions and then revealing branch questions based on the stem questions. Peters includes obtaining and collating information from a plurality of computer users by asking questions using a survey, wherein the information obtained

is added and stored in a database, wherein the survey document includes branched to questions linked to another question or questions such that the branched-to question or questions will only be required to be answered by a respondent user if the respondent user gives a predetermined answer(s) to the question or series of questions to which the branched-to question is linked, wherein the survey document is present to the respondent user as a plurality of screens (where there are a plurality of questions), each screen asking one question and where the screen presenting a branched-to question will not be presented by the display to the remote user unless, he makes one or more predetermined answers to a previous question or questions (col. 1 lines 10-16, col. 3 line 47 to col. 6 line 44, and col. 115 lines 1-23). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned components of Peters within the method of Bonnstetter with the motivation of reducing the amount of time to answer a survey by displaying only questions which are relevant to the user (Peters; col. 6 lines 19-27), reducing the amount of information received from a user (Peters; col. 1 lines 39-49), therefore reducing the cost and amount of storage needed for the responses, and increasing the accuracy of a prediction of an individuals success for a particular job (Bonnstetter; col. 1 lines 33-36 and col. 2 lines 13-22).

Bonnstetter fails to expressly disclose including questions related to life history information, wherein one or more predefined negative indicators is identified based on the life history information and is relevant to predicting a predefined outcome. However, Bonnstetter includes presenting to the individual selected questions related to behavior



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and value characteristics relevant to the job (col. 26 lines 37-41). Sarchione includes using personality and life history information to predict dysfunctional job behavior in the law enforcement occupation, wherein the dysfunctional job behaviors encompass a wide variety of undesirable actions such as absence, theft, and drug use, sexual misconduct, insubordination, and inappropriate verbal conduct toward the public (reads on "predefined outcome"), wherein the life history information was obtained from personal history questionnaires, a structured interview, and/or a background investigation report and including information related to work history, criminal history, and drug use history (reads on "life history information" of "life event"), and wherein life history indices were predictive of job behavior as individuals who engaged in behaviors such as marijuana use, military court martial, and conviction for driving under the influence of alcohol (reads on "negative indicator" and "critical item") had a much higher probability of subsequent disciplinary problems (reads on "predefined outcome") as law enforcement officers than their counterparts who did not engage in such behaviors (page 905 col. 1 par. 2 and col. 2 par. 1-2; page 906 col. 1 par. 1 and col. 2 par. 2-4; Table 1 page 907; page 910 col. 1 all; page 911 col. 1 all). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned components of Sarchione within the method of Bonnstetter with the motivation of increasing the accuracy of a prediction of an individuals success for a particular job (Bonnstetter; col. 1 lines 33-36 and col. 2 lines 13-22) and of accurately forecasting dysfunctional job behaviors which have high public visibility and produce high organization scrutiny – such as that of law enforcement officers, therefore reducing

the occurrences of these behaviors and reducing public outrage and rebuke (Sarchione; page 905, col. 2, second full paragraph).

(B) Method claims 1-3, 11-13, 16, and 32 repeat the same limitations as method claim 43, and are therefore rejected for the same reasons given above, and incorporated herein.

(C) As per claims 4-6 and 8-9, Sarchione includes deriving classes of dysfunctional job behaviors (reads on "negative outcome") and using the classes to predict the probability of subsequent disciplinary problems (reads on "predefined outcome") as a law enforcement officers than counterparts who did not engage in such behaviors (page 905 col. 1 par. 2 and col. 2 par. 1-2; page 906 col. 1 par. 1 and col. 2 par. 2-4; Table 1 page 907; page 910 col. 1 all; page 911 col. 1 all), wherein the classes include absence (reads on "performance deficiency"), theft, drug use, sexual misconduct, insubordination, inappropriate verbal conduct toward the public, disciplinary problems (reads on "objective") (page 905 col. 2 par 1-2; page 906 col. 1 par. 3 and col. 2 par. 1-2). The motivation for combining Sarchione within Bonnstetter is given above in the rejection of claim 43, and incorporated herein.

(D) As per claim 7, Bonnstetter, Peters, and Sarchione fail to expressly disclose the outcome including failure to complete training. However, it is respectfully submitted that when evaluating an applicant for a job, an employer typically takes into consideration

whether or not an applicant would be able to complete the required training based on the applicant's background, and the skilled artisan would have found it an obvious modification to include an outcome of failure to complete training within the method taught collectively by Bonnstetter, Peters, and Sarchione with the motivation of accurately matching an employee with a particular job and accurately predicting the success of persons for defined job positions (Bonnstetter; col. 1 lines 15-63), thus increasing job retention and decreasing training costs by ensuring people remain with the employer reducing the need to train new employees.

(E) As per claim 10, Peters includes allowing a user to input text in response to a question (col. 4 lines 20-25 and col. 6 lines 51-57). As per the recitation of "descriptive information," it is noted that Peter's ability to enter textual information is considered to be a form of "descriptive information." The motivation being to allow complicated text answers to be entered by a user (Peters; col. 6 lines 51-57).

(F) As per claim 14, Bonnstetter, Peters, and Sarchione fail to expressly disclose the stem question response being unable to be altered by the applicant after completion of the question collection. It is respectfully submitted that typically when asking questions related to employment using a computer, the system prevents a user from returning to change answers to previous questions, and the skilled artisan would have found including the feature of preventing the altering of previously answered questions within the method taught collectively by Bonnstetter, Peters, and Sarchione with the motivation

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of receiving answers to questions accurately from applicants (Bonnstetter; col. 1 lines 17-25) and preventing tampering with responses to survey questions.

(G) Claims 15, 17, 25-31, 34-35, 37, and 45 repeat the subject matter of method claims 1-14, 16, 33, 43, and 46, respectively, as a computer readable medium comprised of software for instructing a computer rather than as a series of steps. As the underlying processes of claims 1-14, 16, 33, 43, and 46 have been shown to be fully disclosed by the collective teachings of Peters, Bonnstetter, and Sarchione in the above rejections of claims 1-14, 16, 33, 43, and 46, it is readily apparent that the software on a computer (col. 4 line 63 to col. 5 line 2 and col. 19 lines 40-47) disclosed collectively by Peters, Bonnstetter, and Sarchione includes the software to perform these steps. As such, these limitations are rejected for the same reasons given above for method claims 1-14, 16, 33, 43, and 46, and incorporated herein.

(H) As per claim 33, Bonnstetter discloses assigning numerical ratings based on interrelationships between behavioral and values characteristics so that overall behavior characteristics are weighed with respect to their effect on specific behavior factors for a particular job, and overall values characteristics are weighed with respect to their effects on specific behavior factors for a particular jobs, wherein the interrelationships include correlating attributes such as listening and a high sense of urgency (reads on "psychometric data") (col. 25 lines 40-56 and col. 27 line 5 to col. 28 line 15).

(I) Claim 46 repeats the same limitations as claim 12, and is therefore rejected for the same reasons given for claim 12, and incorporated herein.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure. The cited but not applied prior art teaches a method and apparatus for evaluating a potentially insurable risk (4,975,840), a system for use in a temporary help business (5,117,353), assessment methods and apparatus for an organizational process or system (5,737,494), a method and system for processing career development information (5,978,767), a method and apparatus for administering a survey (6,093,026), an intelligent system for dynamic resource management (6,275,812), a remote job application method and apparatus (6,311,164), and a method and system for matching individuals with behavioral requirements (6,341,267).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

**14. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
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**Or faxed to:**

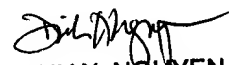
(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-8374 [Informal/ Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

  
CB

February 20, 2003

  
DINH X. NGUYEN  
PRIMARY EXAMINER